

REMARKS

No claims are amended, canceled, or added; as a result, claims 1-24 are now pending in the above-identified patent application.

Objection to the Title

The title was objected to as not being descriptive. 37 C.F.R. § 1.72(a) states that the title of the invention “must be as short and specific as possible.” In addition, MPEP § 606 states, “the title should be brief but technically accurate and descriptive.” Applicant believes the title is descriptive of the invention, and so has not amended the title. Should objection to the title of the pending application be maintained, applicant respectfully requests guidance as to what change in the title is being suggested.

Objection to the Specification

The specification was objected to as not containing a summary of the invention. On page 2 of the Office action, the Examiner refers to MPEP § 608.01(d) and requests the inclusion of a Brief Summary of the Invention per 37 C.F.R. § 1.73. Applicant respectfully notes that neither MPEP § 608.01(d) nor 37 C.F.R. § 1.73 require such a summary. In fact, 37 C.F.R. § 1.73 specifically indicates that such a summary is optional stating, “[s]uch summary should, when set forth, be commensurate with the invention as claimed.” (emphasis added) Applicant therefore submits that a Brief Summary of the Invention is not required, and respectfully requests withdrawal of the objection to the content of the specification.

§102 Rejection of the Claims

Claims 1-13, and 17-24 were rejected under 35 U.S.C. § 102(e) as being anticipated by Shiao (U.S. Patent Application 2002/0091527 A1). Applicant does not admit that Shiao is prior art and reserves the right to “swear behind” Shiao as provided for under 37 C.F.R. § 1.131. Applicant respectively traverses the rejections of claims 1-13 and 17-24.

Claim 1 recites, “a transformation engine to convert a data format used in the contents retrieved from the network into a format supported by a client device.” Claim 12 recites,

“adapting the contents to a client.” Claim 22 recites, “adapting the contents for transmission to a telephone.” In contrast, paragraph (0031) of Shiau states, “The results of the recognition are transferred back to server 303 and passed to HTTP server 302 which provides the query results to client 301.” In paragraph (0032) Shiau states, “VerbalWAP CGI then dynamically generates a WML page responsive to that recognition and the page is transmitted back to client handset 403 via standard WAP gateway 406.” Hence, Shiau fails to teach “a transformation engine to convert a data format used in the contents retrieved from the network into a format supported by a client device,” so Shiau fails to teach each of the elements of claims 1. And Shiau fails to teach, “adapting the contents to a client,” so Shiau fails to teach each of the elements of claim 12. Further, Shiau fails to teach, “adapting the contents for transmission to a telephone,” so Shiau fails to teach each of the elements of claim 22. Thus, the Office action fail to state a *prima facie* case of anticipation with respect to claims 1, 12, and 22. Therefore, applicant requests withdrawal of the rejection and reconsideration and allowance of claims 1, 12, and 22.

Claims 2-11 are dependent on claim 1. Claims 13 and 17-21 are dependent on claim 12. Claims 23-24 are dependent on claim 22. For reasons analogous to those provided above and elements in the claims, applicant respectfully submits that the Office action fails to state a *prima facie* case of anticipation with respect to claims 2-11, 17-21, and 23-24. Therefore, applicant requests withdrawal of the rejections and reconsideration and allowance of claim 2-11, 17-21, and 23-24.

§103 Rejection of the Claims

Claims 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shiau in view of Kitahara *et al.* (U.S. Patent Application 2002/0046035 A1). Applicant does not admit that Shiau is prior art and reserves the right to “swear behind” Shiau as provided for under 37 C.F.R. § 1.131. Applicant does not admit that Kitahara *et al.* is prior art and reserves the right to “swear behind” Kitahara *et al.* as provided for under 37 C.F.R. § 1.131. Applicant respectfully traverses the rejections of claims 14-16.

The Office action must provide specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine reference teachings and must explain the

reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, (Fed. Cir. 2002). The Office action, in an attempt to meet this requirement, on page 6 states, "However, Kitahara teaches wherein the adapting further comprises adapting the contents to screen size, resolution and color depth of the client (§ 0041-0042). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to provide a adapting the contents to a screen size, resolution and color depth of the client because it provides a flexibility to the user select the desired scene in order to display data according to the user's telephone terminal (§ 0075)." The first sentence of this quotation forms the premise of the finding. Quite simply, the phrases "screen size," "screen resolution," and "color depth" are not included in paragraphs 0041-0042 of Kitahara. Thus, the first sentence, the premise is false, so the reasons cannot support the finding of a teaching, suggestion, or motivation to combine the references. Thus, the Office action fails to state a *prima facie* case of obviousness with respect to claims 14-16.

Assuming *arguendo* that there is a teaching, suggestion, or motivation to combine the references, applicant respectfully submits that the Office action still fails to state a *prima facie* case of obviousness with respect to claims 14-16.

Claim 14 recites, "adapting the contents to a screen size of the client." (emphasis added) The applicant respectfully submits that neither Shiao or Kitahara *et al.*, either alone or in combination, teach or suggest "adapting the contents to a screen size of the client." The Office action on page 6 asserts that Kitahara *et al.* teaches adapting the contents to the screen size of the client in paragraphs (0041-0042). However, applicant has read paragraphs 0041-0042 and respectfully submits that the words "screen size" are not used in the cited paragraphs. Hence, the cited references fail to teach each of the elements of claim 14. Therefore, the Office action fails to state a *prima facie* case of obviousness with regards to claim 14.

Further, since the Office action does not cite another reference that teaches or suggests these elements, applicant assumes that the rejection is based on facts within the personal knowledge of the Examiner. Therefore, applicant respectfully requests that the Examiner provide an affidavit as required by MPEP § 2144.03. If the Examiner cannot provide an affidavit, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 14.

Claim 15 recites, “adapting the contents to a screen resolution of the client.” (emphasis added) The applicant respectfully submits that neither Shiau or Kitahara *et al.*, either alone or in combination, teach or suggest “adapting the contents to a screen resolution of the client.” The Office action, on page 6, asserts that Kitahara *et al.* teaches adapting the contents to a screen resolution of the client in paragraphs (0041-0042). However, applicant has read paragraphs 0041-0042 and respectfully submits that the words "screen resolution" are not used in the cited paragraphs. Hence, the cited references fail to teach each of the elements of claim 15. Therefore, the Office action fails to state a *prima facie* case of obviousness with regards to claim 15.

Further, since the Office action does not cite another reference that teaches or suggests these elements, applicant assumes that the rejection is based on facts within the personal knowledge of the Examiner. Therefore, applicant respectfully requests that the Examiner provide an affidavit as required by MPEP § 2144.03. If the Examiner cannot provide an affidavit, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 15.

Claim 16 recites, “adapting the contents to a color depth of the client.” (emphasis added) The applicant respectfully submits that neither Shiau or Kitahara *et al.*, either alone or in combination, teach or suggest “adapting the contents to a color depth of the client.” The Office action on page 6 asserts that Kitahara *et al.* teaches adapting the contents to a color depth of the client in paragraphs (0041-0042). However, applicant has read paragraphs 0041-0042 and respectfully submits that the words "color depth" are not used in the cited paragraphs. Hence, the cited references fail to teach each of the elements of claim 16. Therefore, the Office action fails to state a *prima facie* case of obviousness with regards to claim 16.

Further, since the Office action does not cite another reference that teaches or suggests these elements, applicant assumes that the rejection is based on facts within the personal knowledge of the Examiner. Therefore, applicant respectfully requests that the Examiner provide an affidavit as required by MPEP § 2144.03. If the Examiner cannot provide an affidavit, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 16.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 612-371-2109 to facilitate prosecution of the above-identified patent application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

LIANG HE ET AL.

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Date

September 21, 2004

By

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21 day of September, 2004.

Name

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Signature

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